REMARKS

STATUS OF THE CLAIMS

[0001] Claims 1, 3-8, 10-15, 17-22, and 24-26 remain in the case and stand rejected. Claims 1, 3-8, 10-15, 17-22, and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over "MSN Instant Messenger Protocol," April 23-27, 2002, printed from hypothetic.org, (hereinafter "*MSN*"), and additionally as being unpatentable over alleged "Admitted Prior Art in the Background section of the Specification, (hereinafter "*Related Art*"), in view of U.S. Patent number 7,024,209 to Gress *et al.* (hereinafter "*Gress*"). Claims 1, 3, 8, 10, 15, 17, 22, and 26 are amended. Claims 2, 9, 16, and 23 have been previously cancelled. No claims have been added. Applicants respectfully traverse these rejections in view of the following remarks.

[0002] Claim 10 is amended for depending on itself. Independent Claims 1, 8, 15, 22, and 26 are amended to clarify the claimed invention and to further prosecution. Amendments to independent Claims 1, 8, 15, 22, and 26 are supported in at least paragraphs [0001], [0008], [0022], and [0024]-[0026] of the Specification.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

[0003] Claims 1, 3-8, 10-15, 17-22, and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *MSN* for obviousness, and further for being unpatentable over the *Related Art* in view of *Gress* for obviousness. Applicants respectfully submit that Applicants' *Related Art* is not admitted prior art under *MPEP § 2129*. Applicants further respectfully submit that *MSN* and further *Gress* do not render the claimed invention obvious because they **do not teach each and every element** of the claimed invention and because **each of the Graham Factors indicates non-obviousness**.

[0004] Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. *See MPEP § 2141.III*. As stated by the U.S. Supreme Court in *KSR Int'l*

Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that "…[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1740-1742.

[0005] The U.S. Supreme Court in *KSR* upheld the use of the Graham Factors to determine obvious, the Graham Factors being:

(1) the scope and content of the prior art;

(2) the differences between the prior art and the claimed invention;

(3) the level of ordinary skill in the art; and

(4) any relevant secondary considerations, such as commercial success, long-felt need, and the failure of others. See *KSR* at 1734; *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545. Applicants respectfully submit that an analysis of the Graham Factors clearly shows that neither *MSN* nor *Gress* render the claimed invention obvious, and respectfully request that if the Examiner disagrees with the Applicants, that further rejections include a Graham Factor analysis for each rejection under 35 U.S.C. § 103, as indicated by *KSR* and *MPEP § 2141*.

Applicants' Related Art not Admitted Prior Art Under MPEP § 2129

[0006] *MPEP § 2129* clearly states that, in order for a statement by an applicant to be relied upon as prior art, the applicant must "identify the <u>work of another</u> as 'prior art,'" and further that it must be "labeled as 'prior art.'" (*MPEP § 2129*, emphasis in original). In the case cited in *MPEP § 2129, In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975), the stated holding is that "applicant's labeling of two figures in the application drawings as 'prior art' to be an admission that what was pictured was prior art relative to applicant's improvement."

[0007] The Office Action suggests that Applicants *Related Art* is admitted prior art, referring to it as "the Admitted Prior Art in the Background section of the Specification." (*Office Action*, pg. 11, ¶ 2). Applicants assume that the Office Action is referring to the "Description of

the Related Art" section of Applicants' Specification. Applicants do not admit, in the Specification or otherwise, that the *Related Art* is prior art with regard to the claimed invention. Nowhere is the *Related Art* section, or any portion of it labeled or identified as "prior art" as required by *MPEP § 2129*. Further, Applicants do not admit in the *Related Art* or elsewhere that the described systems and methods are "the work of another" as required by *MPEP § 2129*. Applicants provided the *Related Art* merely as an example to facilitate an understanding of the claimed invention, and did not and do not admit any portion of the *Related Art* as prior art. Applicants respectfully submit that Applicants' *Related Art* is not admitted prior art under *MPEP § 2129*, and request that the rejection of Claims 1, 3-8, 10-15, 17-22, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over the *Related Art* in view of *Gress* be removed.

The Scope and Content of the Prior Art

The MSN Reference

[0008] The *MSN* reference seems to be an unofficial guide to the MSN Messenger protocol, patched together by "eavesdrop[ping] on communications between the MSN client and the server" using packet sniffers. (*MSN*, research_practice.php, ¶¶ 1-2). The portion of the *MSN* reference cited in the Office Action teaches two server message types. (*Office Action*, pg. 4, ¶ 4). "The first one notifies you when a new email has been received. The second notifies you when an email has been deleted (or maybe something else also)." (*MSN*, connecting.php, ¶ 15). The *MSN* reference is silent on "sending an activation message to said non-SMS device over an IP-based messaging protocol," "determining whether said activation message comprises a server initiated action (SIA) message identifier," and "automatically initiating an action contained in an SIA message in said activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue.

The Gress Reference

[0009] The *Gress* reference seems to teach receiving, storing, and sending SMS messages according to an open standards-based protocol. (*Gress*, Abstract). *Gress* teaches that a server

generates a common format message that includes an SMS message, so that the SMS message can be stored according to a different protocol, such as IMAP. (*Gress*, col. 2, line 60 – col. 3, line 8). The SMS message can then be accessed by SMS devices or non SMS-type devices. (*Gress*, Abstract). The *Gress* reference is silent on "sending an activation message to said non-SMS device over an IP-based messaging protocol," "determining whether said activation message comprises a server initiated action (SIA) message identifier," and "automatically initiating an action contained in an SIA message in said activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue.

Applicants' Related Art

[0010] Although Applicants' *Related Art* is not admitted prior art, as described above, the *Related Art* section does not teach "sending an activation message to said non-SMS device **over an IP-based messaging protocol**," and "**automatically initiating an action contained in an SIA message** in said activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue. The *Related Art* teaches "the user then takes action to connect to the enterprise server to download and read the email" instead of automatically initiating an action contained in an SIA message, and further teaches that "for IP networks…there is no such thing as an SS7 signaling channel." (*Related Art*, ¶¶ [0003] – [0005]).

The Differences between the Prior Art and the Claimed Invention

[0011] In direct contrast to the prior art, the claimed invention is directed to "sending an **activation message** to said **non-SMS device** over an **IP-based messaging protocol**, the activation message comprising a **server initiated action (SIA) message identifier** and an **initiation command**, the initiation command comprising an **action for execution on the non-SMS device**; determining whether said activation message comprises the **SIA message identifier**; and **automatically initiating the action from the initiation command** in said activation message in response to the activation message comprising the SIA message identifier,"

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as recited in the claims at issue. (Claim 1, emphasis added). To further clarify the claimed invention, Applicants have presently amended independent Claims 1, 8, 15, 22, and 26 to substantially recite the elements described above.

[0012] Applicants respectfully submit that the *MSN* reference does not teach the elements of independent Claims 1, 8, 15, 22, and 26 as amended. The Office Action is silent on where the *MSN* reference teaches "sending an **activation message** to said non-SMS device over an IP-based messaging protocol." (*Office Action*, pg. 5, ¶ 2). The Office Action further states that "*MSN* does not expressly disclose that the inherent device that receives the message is a 'non-SMS device.'" (*Office Action*, pg. 6, ¶ 3). The Office Action also states that "*MSN* does not disclose 'determining' whether received messages 'contain a server initiated action (SIA).'" (*Office Action*, pg. 6, ¶ 5). The Office Action goes on to state that "*MSN* does not expressly disclose, if the activation message contains an SIA message, configuring the receiving device to 'initiate an action contained in the SIA message.'" (*Office Action*, pg. 7, ¶ 2).

[0013] Applicants agree with the Office Action that the *MSN* reference does not teach even one of the three elements of independent Claim 1. The Office Action seems to suggest that every element of independent Claim 1 is inherent, as *MSN* is silent on each of them. *MPEP §* *2112.IV* provides the requirements to show inherency:

> The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was **necessarily present in the prior art**); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present in the thing described in the reference**, and that it would be so **recognized by persons of ordinary skill**. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " (emphasis added).

[0014] Applicants respectfully submit that the Office Action does not establish that sending an **activation message** to a **non-SMS device** over an **IP-based messaging protocol**, determining whether the activation message comprises a **server initiated action (SIA) message identifier**, and **automatically initiating an action contained in an SIA message** in the

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activation message in response to the activation message comprising the SIA message identifier are **necessarily present** in the MSN messaging protocol taught in the *MSN* reference. Additionally, the amended claims now recite "the activation message comprising a **server initiated action (SIA) message identifier and an initiation command**, the initiation command comprising **an action for execution on the non-SMS device**." (Claim 1, emphasis added).

[0015] Applicants' present amendments are clearly not inherent in the *MSN* reference. The Office Action seems to equate the hotmail email notification of the *MSN* reference with the activation message of the claims at issue. The hotmail email notification clearly does not contain an SIA message, an SIA message identifier, or an initiation command that comprises an action for execution on the non-SMS device. The *MSN* reference does not teach "automatically initiating the action from the initiation command in said activation message." The Office Action suggests that "the claimed 'action' can be merely opening a browser using the 'Message-URL' and 'Post-URL' specified in the email notification." (*Office Action*, pg. 7, ¶ 3). The Office Action further suggests installing a browser so that a user could perform such an action. (*Office Action*, pg. 7, ¶ 4).

[0016] Applicants respectfully submit that the hotmail notification of *MSN* does not contain an action contained in an SIA message, much less "automatically initiating the action from the initiation command in said activation message." The entirety of the hotmail notification is reproduced in the *MSN* reference and in the Office Action, and it clearly does not state "install a browser, open the browser, and display this URL in the browser" or any other action. (*Office Action*, pg. 5). At most, the hotmail notification has an address or location, which is clearly not an action for execution on a non-SMS device. An address or location is a noun, a thing, while an action or instruction is a verb, something that can be performed or executed. If such an action is literally and factually not present "in the thing described in the reference," it cannot be inherent, because it is not "necessarily present" as required by *MPEP § 2112*.

[0017] Similarly, Applicants respectfully submit that the *MSN* reference is also silent on sending an **activation message** to a **non-SMS device** over an **IP-based messaging protocol**, and determining whether the activation message comprises a **server initiated action (SIA) message**

identifier, and that the limitations are not inherent in the *MSN* reference, because they are not necessarily present. A hotmail email notification is not an activation message, and like the action discussed above, the *MSN* reference does not teach that it may comprise a server initiated action message identifier.

[0018] Applicants further respectfully submit that even if the *Related Art* was admitted prior art, neither the *Gress* reference nor the *Related Art* section teach "sending an activation message to said non-SMS device **over an IP-based messaging protocol**," and "**automatically initiating the action from the initiation command** in said activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue. The Office Action again seems to rely on an inherency argument, stating that "it would have been obvious to one of ordinary skill in the art to utilize Gress' system to receive the SIA activation message and retrieve the email accordingly" without an analysis of specific elements of the claims at issue. (*Office Action*, pg. 11, ¶ 3).

[0019] In the claims at issue, the activation message comprises "a server initiated action (SIA) message identifier and an initiation command, the initiation command comprising an action for execution on the non-SMS device." Were the system taught in *Gress* to store an activation message in an IMAP directory and send it as a voice message, fax, e-mail, or the like as taught in the *Gress* reference, it would be unintelligible to a user. An SIA is not meant to be shown to a user, but is instead an action or command. (*Specification*, ¶ [0008]). Such a forced reading is clearly not necessarily present in *Gress* as required by *MPEP § 2112*, and would further destroy the utility of the invention, even if the *Related Art* was admitted prior art.

The Level of Ordinary Skill in the Art

[0020] *MPEP § 2141.II.C* states that:

"The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. Factors that may be considered in determining the level of ordinary skill in the art may include: (1) "type of problems encountered in the art;" (2) "prior art solutions to those problems;" (3) "rapidity with which innovations are made;" (4) "sophistication of the technology; and" (5) "educational level of active workers in the field. In a given case, every factor may not be present, and one or more factors may predominate." In re GPAC, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986); Environmental Designs, Ltd. V. Union Oil Co., 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983)."

[0021] Typical problems encountered in the art of messaging include network connection issues, message spelling errors, client application compatibilities, and the like. Prior art solutions to these problems include the use of simple text protocols to minimize problems. (*See MSN*, research_practice.php, ¶ 2, "The MSN Messenger protocol (like all good Internet protocols) is text-based, so it's relatively easy to work things out by eye").

[0022] Innovations in messaging technology move at a relatively slow pace. SMS and internet messaging are much the same now as they were at the advent of data networks. The underlying messaging protocols are fairly constant and slow to evolve. As stated in the *MSN* reference, the technology is not sophisticated, but is typically based on a relatively easy to work out text-based protocol. (*MSN*, research_practice.php, ¶ 2). For these reasons, active workers in the field of messaging may have a relatively low educational level, with some technical training to troubleshoot connection issues, compatibilities and the like.

[0023] Applicants respectfully submit that the relatively simple problems encountered in the art of messaging, the use of simple, text-based solutions to solve those problems, the relative slow speed of innovation in the area of messaging, the low sophistication of the technology, and the relatively low educational level of active workers in the field each support a finding that a person having ordinary skill in the art of messaging would not find the claimed invention obvious. The relatively few problems encountered in the art of messaging indicate that even

small solutions in the art of messaging are not obvious. The use of simple, text-based solutions to solve those problems indicates that persons having ordinary skill in the art of messaging do not look past currently known solutions. The relative slow speed of innovation in the area of messaging and the low sophistication of the technology further indicates that any innovation in the field of messaging is not obvious. .

Relevant Secondary Considerations

[0024] Evidence of secondary considerations such as commercial success, long-felt need in the art, failure of others, and unexpected results, must always be considered in a determination of obviousness for a patent MPEP § 2141.II; *In re Vamco Machine and Tool, Inc.*, 752 F.2d 1564, 224 U.S.P.Q. (BNA) 617 (Fed. Cir. 1985); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. (BNA) 871 (Fed. Cir. 1983). While Applicants respectfully reserve the right to present evidence of commercial success or other secondary factors at a later date if necessary, the discussion above regarding the differences between the claimed invention and the prior art do show some long-felt need in the art, failure of others, and unexpected results.

[0025] Since the use of IP messaging systems began, no SS7 type channel has existed for Server Initiated Action (SIA) messages. Consequently, non-SMS devices were denied SIA functionality. Although the prior art shows no direct evidence of failure of others, it shows no successes either. The lack of any teaching in the cited art of sending an **activation message** to a **non-SMS device** over an **IP-based messaging protocol**, the activation message comprising **an SIA message identifier and an initiation command comprising an action for execution on the non-SMS device**, determining whether the activation message comprises the **SIA message identifier**, and **automatically initiating the action from the initiation command** in the activation message as recited in the claimed invention is also evidence of unexpected results. While there is only a small amount of evidence of relevant secondary considerations, even that evidence supports a conclusion that the claimed invention is nonobvious in view of the cited art.

[0026] As described above, each of the Graham Factors, including secondary considerations, lead to a clear conclusion that the claimed invention is nonobvious in view of *MSN* and in view of *Gress*, especially because the *Related Art* is not admitted prior art. Applicants respectfully submit that the prior art fails to teach or suggest, either expressly or inherently, "sending an **activation message** to said **non-SMS device** over an **IP-based messaging protocol**, the activation message comprising a **server initiated action (SIA) message identifier** and an **initiation command**, the initiation command comprising an **action for execution on the non-SMS device**; determining whether said activation message comprises the **SIA message identifier**; and **automatically initiating the action from the initiation command** in said activation message in response to the activation message comprising the SIA message identifier." (Claim 1, emphasis added).

[0027] Applicants further submit that although the remarks have focused specifically on the limitations of independent Claim 1 as representative of similar limitations in independent Claims 8, 15, 22, and 26, that independent Claims 8, 15, 22, and 26 contain further limitations that are patentably non-obvious. For example, independent Claim 26 recites "automatically execut[ing] instructions contained in said SIA chat message **to activate said non-SMS device** in response to the SIA chat message comprising an SIA message identifer; and **activating said non-SMS device by sending an SIA chat message to said non-SMS device**, said SIA chat message comprising **an initiation command to activate said non-SMS device** to automatically perform an action contained in said chat message" Applicants respectfully submit that the cited art does not teach activating a non-SMS device by sending an SIA chat message including instructions to activate the non-SMS device.

[0028] For the reasons outlined above, Applicants respectfully submit that independent Claims 1, 8, 15, 22, and 26 are patentable over *MSN*, and over *Gress*, and further that dependent Claims 3-7, 10-14, 17-21, and 24-25 are also patentable for depending on an allowable claim. *See in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully request

that the rejections to Claims 1, 3-8, 10-15, 17-22, and 24-26 under 35 U.S.C. § 103(a) be removed.

<u>CONCLUSION</u>

[0029] As a result of the presented amendments and remarks, Applicants assert that Claims 1, 3-8, 10-15, 17-22, and 24-26 are patentable and in condition for prompt allowance. Should additional information be required regarding the amendments or the traversal of the rejections of the independent and dependent claims enumerated above, Applicants respectfully request that the Examiner notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

Date:_ May 22, 2009__   _/David J. McKenzie/__

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